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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
112740-209

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Application Number	Filed
09/827,485	April 6, 2001

First Named Inventor
Thomas Brumm

Art Unit	Examiner
2616	Daniel J. Ryman

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record. Registration number 48,196

☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

Signature

Peter Zura
Typed or printed name

312-807-4208
Telephone number

September 27, 2007
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s):	Thomas Brumm
Appl. No.:	09/827,485
Conf. No.:	5739
Filed:	April 6, 2001
Title:	TERMINAL OF A PACKET-SWITCHING COMMUNICATION NETWORK AND METHOD FOR OPERATING A TELECOMMUNICATION SYSTEM HAVING A PACKET-SWITCHING COMMUNICATION NETWORK
Art Unit:	2616
Examiner:	Daniel J. Ryman
Docket No.:	112740-209

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

This request is submitted in response to the Final Office Action dated June 27, 2007. This request is filed contemporaneously with USPTO form PTO/SB/33, "Pre-Appeal Brief Request for Review" and form PTO/SB/31, "Notice of Appeal."

Remarks begin on page 2 of this paper.

REMARKS

Claims 28-38 are pending in the present application. Independent claims 28, 37 and 38 are the focus of this request. As is explained below, Appellant respectfully submits the current rejections are improper and should be withdrawn.

Claims 28, 30-32 and 36-38 were rejected under 35 U.S.C. §103(a) as being unpatentable over alleged Applicant's Admitted Prior Art (APA) in view of *Bressler* (US Patent 6,584,190). Claims 33-35 were rejected under 35 U.S.C. §103(a) as being unpatentable over alleged Applicant's Admitted Prior Art (APA) in view of *Bressler* (US Patent 6,584,190) and *Baratz et al.* (US Patent 5,742,596).

The Applicant's initial arguments traversing the present rejections may be found in the Response dated May 17, 2007. As was acknowledged in the Final Office Action, the APA does not disclose that the processing device configures second signaling information according to a standard signaling protocol for circuit-switched telecommunication that is processed under a second protocol stack and that the second signaling information is transmitted through the interface with the assistance of data packets of a packet-switched communication network (see Final OA, page 7, first full paragraph).

At the outset, Applicant respectfully notes that the Office Action, after citing the Background section of the application, states that "[a]pplicant does admit as prior art that there are certain services in the circuit-switched network that cannot be supported by H.225 signaling (p. 4, lines 7-9), and then proceeds to use this as an apparent reason why one having ordinary skill and creativity in the art would combine the Background with Bressler (Final OA, page 8, lines 8-15). Applicant submits that such reasoning in formulating the obviousness rejection is improper.

For one the sentence cited above from the Final Office Action does not provide the proper context of the statement. Specifically, the Background describes CENTREX groups within a network, and some of the features provided in CENTREX (page 3, line 10 - page 4, line 3). The Background continues (page 4, lines 3-9), stating that,

> However, with the prior art, it is possible to use the CENTREX service and other services known on voice connections, such as three-way conferencing, call forwarding, call transfer, subscriber cut-in, recorded announcement services and private call number schedule only in a line-switching communication network. According to the H.323/H.450 Standard, these services are not supported for voice connection using the packet-switching communications network, or not to the same extent (emphasis added).

Thus, if anything, this passage merely describes the inability of services such as CENTREX to support voice connections over a packet-switched communication network. Furthermore, the Office Action is apparently using the *Applicant's own disclosure* as a reason to combine Bressler. Applicant respectfully submits that such a combination is improper - the deficiencies as identified by the Applicant cannot simultaneously be used by the Office as a reason to make a combination with other prior art. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Appellant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (MPEP 2142).

As argued in Applicant's previous Response (page 6, first full paragraph), Bressler does not address terminal devices, but addresses network node communication, which is based on a different telecommunication standard (ANSI T1.111; SS7). The Final Office Action notes (page 3, lines 8-14) that Bressler discloses that other standards or protocols for exchanging telephony control signaling may be used (col. 2, lines 6-15, 62-64). The Final Office Action also states that the aforementioned disclosure "suggests that Bressler's system could be used with various types of protocols and, by extension, various types of devices" (page 3, last 3 lines of paragraph 2). However, the Office Action fails to disclose in any way how Bressler could be modified given the disclosure in Bressler and the knowledge in the art. Applicant respectfully submits that the mere mention that "other protocols may be used" does not give the Office license to combine any teaching that is outside the scope of the cited reference.

Bressler generally states that the disclosure related to signaling is not limited to SS7 protocols per se, but the term "link" that is disclosed consistently throughout Bressler only discloses links that are a product of SS7 signaling (see col. 3, lines 51-67). Bressler provides

additional examples of links (S7Links, IPLinks - see col. 13, line 50), however, it would be understood by one having ordinary skill in the art that such links are byproducts of SS7 as well. Furthermore, Bressler only addresses the message transfer part (MTP) protocol layer of the protocol stack, which deals with communication between nodes or between PSTN exchanges (col. 1, lines 25-28; col. 6, lines 21-37). There is no teaching or suggestion in Bressler that would make the MTP protocol applicable for interfacing a terminal device to a communication network.

The Office Action is also inconsistent in the fact that reliance on the APA in the Office Action would define terminals as terminating devices (page 2, last paragraph), and yet the Office Action attempts to combine signaling directed to nodes/exchanges, as disclosed in Bressler. Furthermore, The SS7 arrangement of Bressler (col. 6, lines 21-37) and the "encapsulation" of SS7 messages into UDP/TCP packets (col. 4, lines 57-67) makes clear that the signaling used for inter-node communication is done under the same stack (IPLink - see col. 10, lines 45-56).

Appellant maintains that there is no apparent reason why one skilled in the art would combine the elements described in the Background with Bressler. As discussed above, the function and structure of the encapsulated MTP/SS7 signaling is different from the presently claimed features and the protocol is inapplicable for terminal devices connecting to a network. The Office Action does not provide any evidence that the combination would yield predictable results, nor that one having ordinary skill in the art would recognize any benefit from utilizing Bressler in combination with the Background features.

Regarding claims 33-35, Baratz fails to solve the deficiencies of the documents described above. As argued previously, Baratz discloses a terminal representing a conventional PC utilizing a Novell network protocol (col. 5, lines 39-42), where a PC is equipped with a telephone client module TCM (174), and bits of signaling information, which are fashioned according to a PBX telecommunications standard, are transmitted in packets to the telephone (col. 4, lines 35-48). The PC receives the packets in a customary manner and processes these according to the standard Novell protocol, and the signaling contained in the packets is removed and forwarded to the TCM 174 (col 5, lines 31-53; col 9, lines 42-67). In order to process the signaling, the TCM 174 has only one protocol stack which is exclusively reserved for processing

the PBX protocol (col. 1, lines 65-67: "[i]t is an object of the present invention to provide an improved network based PBX system that integrates voice and data traffic within a single network infrastructure").

Furthermore, there is no apparent reason why one skilled in the art would combine Bartz with the elements described in the Background and Bressler - Bartz teaches that the Novell/PBX protocol is the only telecommunications protocol that is supported by the PC, and an additional packet-oriented telecommunications protocol is not supported within the teaching of Baratz. This clearly teaches away from the APA and Bressler. For at least these reasons, Applicant submits the rejections under 35 U.S.C. §103 are improper and should be withdrawn

For at least these reasons, Applicant respectfully submits the rejections are improper and should be reversed. In light of the above, Applicant respectfully submit that claims 28-38 are allowable. Applicants respectfully submit that the patent application is in condition for allowance and request a Notice of Allowance be issued. The Commissioner is authorized to charge and credit Deposit Account No. 02-1818 for any additional fees associated with the submission of this Response. Please reference docket number 112740-209.

Respectfully submitted,
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Dated: September 27, 2007